

### **Remarks/Arguments**

Claims 19-27 and 35-48 have been examined. Applicants note with appreciation the allowance of claims 47 and 48 and the indication that claims 23, 40, and 41 define allowable subject matter. New claim 49 is respectively claim 23 rewritten in independent form including all of the limitations of the base claim. Hence, claim 49 is in condition for allowance.

Claims 19 and 42 have been amended. Re-examination and reconsideration of remaining pending claims 19-22, 24-27, 35-39, and 42-46, as amended, are respectfully requested.

### Rejections Under 35 U.S.C. § 102

Claims 19-22, 24-27, 35-39, and 42-46 have now been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,105,581 issued to Eggers et al. This rejection is traversed in part and overcome in part as follows.

To expedite prosecution of this case and more clearly claim the present invention, Applicants have amended claim 19 to recite a device for effecting a desired contraction of a discrete target region of a tissue so as to treat incontinence, the target region having a target region size and shape. The device of claim 19 now recites a static vaginal probe having a treatment surface, the treatment surface size and shape corresponding to the size and shape of the target region and having a length of at least 10 mm and width of at least 5 mm. Further, at least one rounded protruding element having a radius of curvature in a range from about 0.05 mm to about 2 mm is disposed along the treatment surface and engageable against the target region for transmitting energy from the treatment surface to the target region without moving the probe such that the energy effects the desired contraction of the target tissue without ablating the target tissue, and so that the contracted target tissue inhibits the incontinence.

As the Examiner certainly knows and appreciates, a single cited art reference must teach each and every element of the claim to establish anticipation under 35 U.S.C. § 102. M.P.E.P. § 2131. The Court of Appeals for the Federal Circuit has held

that, "the identical invention must be shown in as complete detail as is contained in the .... claims." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The present invention encompassed by amended claim 19 defines several structural limitations that are neither shown or suggested in Eggers et al. The Eggers et al. patent describes a planar ablation probe (404) having a plurality of electrodes (416) for applying ablative RF energy to spinal tissue for treating herniated discs. The Examiner notes that "the electrodes (416) protrude from the probe and have a rounded surface." Office Action, page 2. Applicants respectfully disagree. Upon a closer examination of this patent, it is clear that the electrodes in the Eggers planar probe have a "u" shape configuration. In particular, as shown in Figs. 25A and 31, the active electrodes (416) of the planar ablation probe (404) are constructed from a tube with at least the distal portion (432) being filed off so as to form first and second electrode ends (440, 442) that engage the spinal tissue. Col. 23, lines 47-51. Further, this semi-cylindrical configuration is preferred as it increases the electric field intensity and associated current density around the electrode ends (440, 442). Col. 23, lines 57-61; Col. 26, lines 45-49. In stark contrast, the present invention now provides a rounded protruding element that is oriented to be engageable against the target tissue. As noted in the present application on page 12, lines 7-10, the protruding electrodes present a rounded surface for engagement against the fascial tissue so as to minimize the concentration of electrical current density as might otherwise occur at sharp corners (i.e., like those exhibited by Eggers electrode ends 440, 442).

In addition, the present invention requires a static probe so that that energy is transmitted to the target region without moving the probe. The Eggers et al. patent instead clearly teaches that the probe electrodes are translated across the surface of the spinal tissue as shown by the motion vector 523 in Figs. 30 and 31. Col. 26, lines 1-9. Moreover, the presently claimed device provides a vaginal probe that contracts the target tissue to inhibit urinary stress incontinence. The Eggers et al. patent is generally directed to the ablation of spinal tissue. In Col. 3, lines 30-35, the treatment of leiomyomas

(fibroids) located in the uterus is briefly mentioned, as noted by the Examiner. Office Action, page 2. However, this reference still falls far short of suggesting a vaginal probe for the treatment of incontinence, as claimed by claim 19.

Hence, for the several reasons discussed above, Applicants respectfully request withdrawal of the 35 U.S.C. § 102 rejection and allowance of independent claim 19 (and dependent claims 20-27 and 35-41).

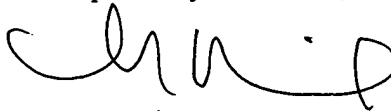
Independent claim 42 similarly recites a novel static urinary incontinence device. In particular, it requires, in part, a static vaginal probe body having at least two protruding elements having a rounded surface that engage the target tissue. As such claim 42 (and dependent claims 43-36) should be allowable for many of the reasons given above with respect to claim 19.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Nena Bains  
Reg. No. 47,400

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
NB:gsh  
11455824 v1